DETAILED ACTION

Status of Claims

1. Claims 1-2, 6, 8, 12-18, 35-36, 41, 45-48, 60-63 are pending.

Priority

2. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119 (e) as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 60/179,548, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application.

- The provisional application fails to suggest that the "promotion is selected based upon the content of the program" as recited in claims 2 and 36;

- The provisional application fails to provide adequate support for "recording a flag with the promotion to indicate the beginning of the program during playback" as recited in claims 8 and 41;
- The provisional application fails to provide support for the particular method of distribution of the program, the promotion, and the program guide over either a "single broadcast channel" or a "plurality of broadcast channels" as recited in claims 14, 15, 46, and 47;
- The provisional application does not disclose details regarding the storage of the program, the promotion, and the program guide data with a "storage unit" or a "plurality of storage units", as recited in claims 16, 17, 48, and 62-63.
- The provisional application does not disclose details regarding the program, the promotion, and the television program guide data being received on-demand from a television distribution facility as recited in claim 60.

Accordingly, claims 2, 8, 14-17, 36, 41, 47-48, 60, and 62-63 do not receive the benefit of priority and are being examined on the basis of the application filling date or 01 February 2001.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1, 6, 8, 12-13, 16-18, 35, 41, 45, 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. (Patent # US 5353121) in view of Goldschmidt Iki et al. (hereinafter "Iki", Patent # US 6483987), further in view of Barton et al. (Pub # US 2001/0049820).

As to claim 35, Young discloses a system for providing an integrated recorded program/promotion playback asset (Fig. 22A, 22B), the system comprising:

a user input device (e.g., remote controller 130; Fig. 21) configured to receive a user input to select a television program to be recorded (i.e., receives record command when user press Record It Key 148) (see col. 18, lines 3-20); and

user equipment (Fig. 22A, 22B) operative to:

receive a selected program (e.g., receives television program at tuner 207);

determine whether the selected program is to be recorded (e.g., examining program titles in schedule with requested recording program title);

in response to determining whether the selected program is to be recorded (i.e., CPU 228 and/or controller 220 issues a record command):

record the selected program for inclusion in the integrated recorded program/promotion playback asset (e.g., records television program using VCR);

play back the recorded program/program playback asset in response to receiving a user indication to play back the recorded selected program (see col. 8, line 36-col. 9, line 8; col. 19, line 1-col. 20, line 13).

Young does not explicitly disclose selecting a promotion to record.

In an analogous art, Iki discloses selecting a promotion to record for inclusion in the integrated recorded program/promotion playback asset (e.g., recording programs with commercial; 610 in Fig. 6) (see col.8, line 59-col. 9, line 7; Fig. 6);

recording the selected promotion for inclusion in the integrated recorded program/promotion playback asset (see col. 8, line 59-col. 10, line 5; Fig. 5-8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have an option of recording advertisements as taught by Iki to the recording system of Young in order to provide a system automatically records television program either with or without commercials as preferred by the user (see col. 1, lines 19-46).

Young and Iki fail to disclose the selected promotion is inserted at one of the beginning of the program or the end of the program;

In an analogous art, Barton discloses the selected promotion is inserted at one of the beginning of the recorded selected program or the end of the recorded selected program (see paragraph 0014).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have inserting the promotion as taught by Barton to the recording system of Young as modified by Iki in order to present advertisements to viewers that do not usurp the broadcaster's advertising space (see paragraph 0010).

As to claim 1, it contains the limitations of claim 35 and is analyzed as previously discussed with respect to claim 35 above.

As to claim 6, Young discloses the method of claim 1 further comprising recording both the selected program and the selected promotion on a storage unit (e.g., VCR 252; Fig. 22B).

As to claim 8, Young discloses the method of claim 7, further comprising recording a flag with the selected promotion to indicate the beginning of the selected program during playback (see col. 19, 46-61).

As to claim 12, Iki discloses the method of claim 1 further comprising receiving the selected program and the selected promotion (see col. 3, lines 3-9).

As to claim 13, Young discloses the method of claim 12 further comprising receiving program guide data (see col. 18, lines 37-55).

As to claim 16, Young discloses the method of claim 13 further comprising storing the selected program, the selected promotion, and the program guide data (see Col 18, Lines 37-55; Col 19, Line 62 – Col 20, Line 13).

As to claim 17, Young discloses the method of claim 16 wherein the selected program, the selected promotion, and the program guide data are stored on a storage unit (e.g., VCR 252; Fig. 22B).

As to claim 18, Young discloses the method of claim 16, wherein the selected program, the selected promotion, and the program guide data are stored on a plurality of storage units (e.g., RAMs 232, 234, 236, 238, 240 and VCR 252; Fig. 22B).

As to claims 41, 48, they contain the limitations of claims 8, 18 and are analyzed as previously discussed with respect to claims 8, 18 above.

As to claim 45, Young discloses the system of claim 35 further comprising a receiver that receives signals and data (Fig. 22A, 22B).

5. Claims 2, 11, 14-15, 36, 44, 46-47, 62-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. (Patent # US 5353121) in view of Goldschmidt Iki et al. (hereinafter "Iki", Patent # US 6483987), further in view of Barton et al. (Pub # US 2001/0049820), further in view of Zigmond et al. (Patent # US 6698020).

As to claim 2, note the discussion above, Barton discloses the DVR system selects ads for recording base on the user viewing preferences (paragraph 0048). Young, Iki, and Barton do not specifically disclose the selected promotion is selected based upon the content of the selected program.

Zigmond discloses the selected promotion is selected based upon the content of the selected program (see col. 12, line 60-col. 13, line 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have program related advertisements as taught by Zigmond to the recording system of Young as modified by Iki and Barton to specifically target, deliver, and present individually targeted advertisements to viewers and effectively reach the consumer (see col. 3, line 45 – col. 4, line 3).

As to claim 14, Young and Zigmond disclose the method of claim 13 wherein the selected program, the selected promotion, and the program guide data are received on a single broadcast channel 4 (see Zigmond Col 7, Lines 1-25; Col 14, Line 66 – Col 15, Line 16)(Young et al.: Col 18, Lines 37-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the advertisement as taught by Zigmond to the recording system of Young as modified by Iki and Barton in order to provide a means to specifically target, deliver, and present individually targeted advertisements to viewers regardless of the source of the media in order to effectively reach the consumer (see col. 3, line 45 – col. 4, line 3).

As to claim 15, Young and Zigmond disclose the method of claim 13 wherein the selected program, the selected promotion, and the program guide data are received on

a plurality of broadcast channels (see Zigmond Col 7, Lines 1-25; Col 14, Line 66 – Col 15, Line 16)(Young et al.: Col 18, Lines 37-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the advertisement as taught by Zigmond to the recording system of Young as modified by Iki and Barton in order to provide a means to specifically target, deliver, and present individually targeted advertisements to viewers regardless of the source of the media in order to effectively reach the consumer (see col. 3, line 45 – col. 4, line 3).

As to claims 36, 46-47, they contain the limitations of claims 2, 14-15 and are analyzed as previously discussed with respect to claims 2, 14-15 above.

As to claim 62, Zigmond discloses the method of claim 1, wherein the selected promotion is inserted by accessing a storage device (e.g., advertisement repository 86) (see col. 15, lines 24-34).

As to claim 63, Zigmond discloses the system of claim 35, wherein the user equipment further comprises a storage device, wherein the storage device is accessed to insert the selected promotion (e.g., advertisement repository 86) (see col. 15, lines 24-34).

6. Claims 60-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young in view of Iki, further in view of Barton, further in view of Zigmond, and further in view of Michaud (WO 99/57904).

As to claim 60, note the discussion above, Young, Iki and Barton do not disclose the promotion is received on-demand.

Zigmond discloses the program and the promotion are received on-demand from a television distribution facility (e.g., user requests the program and advertisement) (see col. 14, lines 25-35; col.18, lines 29-37).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the advertisement as taught by Zigmond to the recording system of Young as modified by Iki and Barton to specifically target, deliver, and present individually targeted advertisements to viewers and effectively reach the consumer (see col. 3, line 45 – col. 4, line 3).

Young, Iki, Barton and Zigmond fail to disclose the program guide data is received on-demand from a television distribution facility.

Michaud discloses the program guide data is received on-demand from a television distribution facility (see page 11, line27-page 13; Fig. 3).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have program data on-demand as taught by Michaud to the recording system of Young as modified by Iki, Barton and Zigmond in order to

minimizing the usage of local memory in the user equipment in order to reduce the cost of the equipment (Michaud: Page 3, Lines 24 – Page 4, Line 8).

As to claim 61, Michaud discloses the system of claim 45, wherein the receiver receives signals and data on-demand from a television distribution facility (see page 11, line27-page 13; Fig. 3).

Response to Arguments

7. Applicant's arguments filed 1/28/2010 have been fully considered but they are not persuasive.

Rejections under 35 U.S.C. § 112, second paragraph has be withdrawn in light of the amendment.

Applicant argues "*Young, Iki and Barton do not show, in response to determining whether a selected program is to be recorded, recording the selected promotion for inclusion in an integrated recorded program/promotion playback asset such that the selected promotion is inserted at one of the beginning of a recorded selected program or the end of the recorded selected program*".

However, the examiner respectfully disagrees. Young discloses a system that allows user to select a television program to record. Young does not specifically disclose recoding a promotion with the selected television program. Iki discloses a recording system that allows user to record television programs with/without advertisements (promotion). The advertisements are recorded based on the user

selection (user selects record programs with advertisements). Once the television program is selected for recording, the advertisements broadcasting during the television program are also selected. Thus, the user selects record a television program with advertisements which will cause the advertisements to be recorded. Therefore, recording the advertisements is in response to record a selected program (when user selects record with advertisements). Young and Iki fail to disclose the selected promotion is inserted at one of the beginning of the program or the end of the program. Barton discloses the selected promotion is recorded at the DVR and inserted at one of the beginning of the recorded selected program or the end of the recorded selected program. Barton also discloses "*Since the DVR system knows the viewer's* ***program preferences*** *(e.g., science fiction, police dramas) and, possibly, the viewer's personal information (e.g., male, age 27, likes photography),* ***ads can be selected*** *by the Bookend Program module 904 based on this information. The Bookend Program module 904 selects ads targeted to the specific audience that the viewer is a part of. This allows the DVR service provider to charge advertisers for targeted advertising which is much more valuable than shotgun advertising that occurs in normal television commercial breaks*" (see Barton paragraph 0048). In other words, when a program is selected for recording, the DVR system can base on the selected program (i.e., skilled artisans would understand that the user viewing preferences is generated base on the user's activity, such as watched program and selected program for recording) to select ads for recording. Thus, Barton also suggests the system will record ads are based on

the selected recording program. Therefore, the combination of Young, Iki and Barton disclose the claimed invention.

Applicant further argues Iki teach away from the claimed invention.

The examiner respectfully disagrees. As states by the applicant "*it either completely eliminates all commercials from a recorded program, or allows for the recording of program with all of the commercials that were originally broadcast with the program*". One the option that Iki discloses is completely eliminates all commercials that broadcasting during breaks **within the same program** (see Fig. 6 of Iki). Applicant's claimed invention is recording commercials between different programs (no commercials within the same program) (see Fig. 9 in the application). Therefore, Iki and applicant's claimed invention are on the similar approach, eliminates all commercials within a program. Thus, Iki's reference does not teach away.

Inter alia, applicant's arguments are not persuasive and the rejection maintained.

Conclusion

8. Claims 1-2, 6, 8, 12-18, 35-36, 41, 45-48, 60-63 are rejected.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUN FEI ZHONG whose telephone number is (571)270-1708. The examiner can normally be reached on M-F, 7:30~5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hirl can be reached on 571-272-3685. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JFZ
4/20/2010

/Joseph P. Hirl/
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